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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/726,806 | 12/03/2003 | Benjamin F. James IV | IND-38DIV | 4108 |
| 27777 | 7590 | 11/18/2004 | EXAMINER | |
| PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003 | | | KIM, JOANNE H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2883 | |

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,806

Applicant(s)

JAMES ET AL.

Examiner

Joanne H. Kim

Art Unit

2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/03/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 17, 19, 22, and 30 are objected to because of the following informalities:

in claim 17, line 2, "the sleeve distal" lacks antecedent basis;

in claim 19, line 2, "the sleeve distal" lacks antecedent basis;

in claim 22, line 2, "the inner surface" lacks antecedent basis; and

in claim 30, line 9, "a light transmitting sleeve" should be "the light transmitting sleeve."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15-16 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalton (U.S. Patent No. 6,138,046).

Dalton discloses a method of forming a medical device comprising the steps of: providing an optical fiber core having a proximal end and a distal face; associating the proximal end of the core with an optical connector; enclosing the optical fiber core in a

Art Unit: 2883

continuous uninterrupted light transmitting sleeve by extending the sleeve distally of the distal face of the optical fiber core, wherein the sleeve has a length at least substantially the length of the optical fiber core extending from the optical connector to the distal face of the optical fiber core (Fig. 1, column 8, lines 28-38, and column 9, lines 61-67).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thielen et al. (U.S. Patent No. 6,315,775, hereinafter "Thielen").

6. Regarding claim 24, Thielen discloses a method of making a device comprising the steps of: exposing a distal portion of an optical fiber core; sliding a sleeve over the fiber core; and providing an optical coupling layer intermediate the distal portion of the optical fiber core and the sleeve (column 2, lines 43-45 and 64-66; column 3, lines 25-27, and Fig. 1).

Thielen does not disclose sliding the sleeve over substantially the full length of the fiber core, wherein the sleeve is a continuous and uninterrupted sleeve.

It would have been obvious to one of ordinary skill in the art to modify Thielen to slide a continuous and uninterrupted sleeve over substantially the full length of the fiber core in order to protect the fiber from being affected by external agents.

7. Regarding claim 29, Thielen as discussed above discloses the method of making a device.

Thielen, however, does not disclose that the method includes the step of abrading a portion of the inner surface of the sleeve.

As disclosed in page 2 of the specification of the present application, it is known to abrade the sleeve in order to conduct light from an optical coupling layer to the exterior.

It would have been obvious to one of ordinary skill in the art to modify Thielen to include the step of abrading a portion of the inner surface of the sleeve in order to conduct light from the optical coupling layer to the exterior.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 2883

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 15-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-9 of U.S. Patent No. 6,522,806. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 15-21, 23-28 and 30 merely recite the structure recited in claims 1-4 and 6-9 of U.S. Patent No. 6,522,806. For example, claim 15 of the present application and claim 1 of U.S. Patent No. 6,522,806 disclose a medical device comprising: an optical fiber core having a proximal end associated with an optical connector and a distal face, and a continuous, uninterrupted sleeve having a length at least substantially the length of the optical fiber core extending from the optical connector to the distal face of the optical fiber core.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne H. Kim whose telephone number is (571) 272-2139. The examiner can normally be reached on 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2883

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joanne H. Kim
Examiner
Art Unit 2883

jhk/FGF



Frank G. Font
Supervisory Patent Examiner
Technology Center 2800